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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,768	12/12/2001	James Parr	57095-5010	6865

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EXAMINER

PULLIAM, AMY E

ART UNIT PAPER NUMBER

1615

DATE MAILED: 11/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/017,768

Applicant(s)

PARR ET AL.

Examiner

Amy E Pulliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Receipt of Papers***

Receipt is acknowledged of the Request for Two Months Extension of Time and the Request for Reconsideration, both received by the Office August 20, 2003.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's claim 1 includes percentages for each component of the invention (a, b, and c). Additionally, Applicant's claim 1 includes a ratio of component (a) to component (b). However, the claimed weight percentages are not commensurate in scope with the claimed ratios. Based on the claimed ratios, it is impossible for (b) to be as low as 0.1%, or for a to be as high as 25%. The examiner has thus relied upon the broader teaching, the claimed weight percentages, in examining the pending claims. Appropriate correction is required.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,020,367 to Duffy *et al.*.

Duffy *et al.* disclose a method of preparing a stable solution of ascorbic acid (abstract). Duffy *et al.* teach the inclusion of polyols, such as polyoxyethylene glycol, which reads on Applicant's claimed polymer with humectant properties (column 6, line 45). Additionally, Duffy *et al.* teach that the ascorbic acid is preferable L-ascorbic acid (vitamin C) (column 6, line 64 – column 7, line 1). Duffy *et al.* also teach that the composition can be used in any cosmetic, dermatological, or pharmaceutical utility (column 7, lines 25-28). The composition can also comprise humectants, such as urea, at between 1.0 to 15.0 wt. % (column 8, lines 12-15). Duffy *et al.* also teaches the presence of a thickening agent, such as xanthan gum, which reads on Applicant's claim to a cationic polymer (column 8, line 6). Additionally, Duffy *et al.* teach the

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inclusion of emollients, such as silicone oils (column 7, lines 59-62). The reference also teaches that the invention can be present as an emulsion, specifically a water in oil in water type or an oil in water type (column 9, line 63 – column 10 line 5). Most importantly, as shown in example 1, Duffy *et al.* teach that L-ascorbic acid is present in the formulation at 15.0 weight percent (column 10, example 1). This clearly falls within Applicant's claimed range of 2-25 weight %.

Duffy *et al.* do not clearly set forth the ratio of (a) to (b) as recited in Applicant's claim 1. However, as discussed above, in the 112, second paragraph rejection, this ratio does not make sense when compared to the weight percents recited earlier in the claim language. The reference teaches amounts of Applicant's ingredients (a), (b), and (c) which fall within the ranges claimed by Applicant. As the examiner has interpreted the claims based on the broader limitation (the claimed weight percentages), the reference clearly suggests the claimed amounts of each ingredient.

Duffy *et al.* do not clearly teach that the composition is stable at a pH from about 2 to 7 at room temperature (claim 3). However, Duffy *et al.* do clearly teach that the formulation is stable over time, temperature changes, and other environmental factors (abstract). Absent evidence to the contrary, the examiner interprets this passage to include changes in pH (an obvious environmental factor).

Duffy *et al.* do not teach the inclusion of Applicant's specific surfactants. However, Duffy *et al.* do state the surfactants can be included in the formulation (column 7, line 30). The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the Applicant's specific selection.

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It is the position of the examiner that the teachings of Duffy *et al.* suggest the limitations of Applicant's instant claims. One of ordinary skill in the art would have been motivated to make an emulsion composition comprising the ingredients discussed above. The expected result would be a successful cosmetic, pharmaceutical, or dermatological formulation. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.


### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is 703-308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, Alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A. E. Pulliam  
Patent Examiner  
Art Unit 1615  
November 14, 2003

  
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